



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/728,785      | 11/30/2000  | Rich Robinson        | P209/1938P          | 2704             |

29141 7590 05/21/2004

SAWYER LAW GROUP LLP  
P O BOX 51418  
PALO ALTO, CA 94303

|          |
|----------|
| EXAMINER |
|----------|

VAUGHN, GREGORY J

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2178

DATE MAILED: 05/21/2004

3

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/728,785

Applicant(s)

ROBINSON ET AL.

Examiner

Gregory J Vaughn

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Application History*

1. This action is responsive to the application filing, Application filed on 11/30/2000.
2. Claims 1-32 are pending in the case, claims 1, 10, 16 and 25 are independent claims.

### *Drawings*

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

- "70" on page 5, line 19.
- "110" on page 6, line 8.
- "22" on page 7, lines 8, 11, 12 17, 19 and 21; page 8, lines 6, 7, 14 and 19; page 9, lines 8, 9 and 20; page 10, lines 4-7, 10, 11, 13, 14, 16, 18 and 22; page 11, line 2; page 12, line 21; page 13, lines 7, 9 and 12.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:

- "212" in Figure 4A.

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Specification***

5. The disclosure is objected to because of the following informalities:
- The disclosure recites those reference signs listed in paragraph 3 above, which are not shown in the drawings.
  - The disclosure fails to disclose those reference signs listed in paragraph 4 above, which are shown in the drawings.

Appropriate correction is required.

6. The use of the following trademarks has been noted in this application:
- “*Digita*” on page 5, line 19.

It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

**Claim Rejections - 35 USC § 102**

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*"A person shall be entitled to a patent unless –*

*(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."*

8. Claims 1, 7, 8-10, 16, and 22-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Pavley US Patent 6,445,460 (filed 4/13/1999, patented 9/3/2002).
9. **Regarding independent claim 1,** Pavley recites: *"FIG. 4 illustrates a diagram of one embodiment for an image file 835. Image file 835 includes a header 805, image data 810, a scrennail 815, a thumbnail 820, and image tags 825. Header 805 preferably includes information that identifies and describes the various contents of image file 835. Image data 810 contains actual captured image data"* (column 4, lines 44-50). Pavley also recites: *"With the present invention, file attributes are used in order to synchronize file handling in a photosystem environment, i.e., between a digital camera 110 and an externally connected computer system, as represented in FIG. 6. For purposes of illustration, camera 110 is shown connected with a desktop computer system 1100 and an Internet web server computer processing system*

1102" (column 5, lines 46-52). Pavley also discloses in Figure 7, at reference sign 1208 a plurality of image files (shown as "*Another Image File?*"). Pavley further recites: "*FIG. 7 illustrates a flow diagram of an overall process for automatic image file handling in accordance with the present invention. The process initiates with selection of a desired rule set (step 1200). The rule set may be set up and selected in the camera 110, the desktop system 1100, and/or the server system 1102. A system's file manager program supports application of a rule document on a list of files by opening each image file and examining the file attribute(s) associated with an image file (step 1202)*" (column 6, lines 24-33).

10. **Regarding dependent claim 7**, Pavley recites: "*By way of further example, a goal may be established to conserve time by automatically having image transfer occur between the camera 110 and a computer system, e.g., system 1100, in the photosystem environment. A rule set establishes that image files not marked as archived are copied from the camera 110 to the system 1100 upon connection and are then marked as archived with an archive file attribute by the system 1100*" (column 6, lines 10-17), (compare "*when image files are received*" to "*the camera to the system upon connection*").
11. **Regarding dependent claim 8**, Pavley recites: "A hidden file attribute provides a privacy feature that allows certain image files to be hidden and requires a password to access the file" (column 5, lines 36-39), (compare "*when image files are viewed*" to "*access the file*").

12. **Regarding dependent claims 9 and 24**, the claims are rejected for fully incorporating the deficiencies of the base claims.
13. **Regarding independent claims 10 and 16**, the claims are directed toward a computer readable medium or a system for the method of claim 1, and are rejected using the same rationale.
14. **Regarding dependent claim 22**, the claim is directed toward a system for the method of claim 7, and is rejected using the same rationale.
15. **Regarding dependent claim 23**, the claim is directed toward a system for the method of claim 8, and is rejected using the same rationale.

***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*"(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."*

17. Claims 2, 3, 11, 12, 17, 18 and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pavley in view of Gao, US Patent 6,581,094, filed 11/2/1999, patented 6/17/2003.

18. **Regarding dependent claims 2 and 3**, Pavley discloses an image capture device that stores digital images in image files, where the files contain an image identifier and image data stored in tags, the image files received over a network and assessable by a user as described above. Pavley fails to disclose receiving tag definitions over a network that enable the development of a camera application that uses the custom tags and a key ID. Gao teaches the development of custom camera applications based upon device specific criteria. Gao recites: *"the following code defines profile attributes 124. The code defines attributes for a number of devices, including a printer, projector, camera"* (column 7, lines 57-58, emphasis added). Gao also recites: *"The memory 48 also stores device vendor applications 54. The device vendor applications 54 allow a vendor of digital devices to supply updates and enhancements to digital devices within the networked environment 20"* (column 2, line 67 to column 3, line 3). Gao defines the control of vendor applications as: *"The memory 72 also stores Universal Device Descriptor (UDD) files 76. The UDD files 76 may include a UDD file for the server 60 and UDD files for other digital devices within the networked environment 20"* (column 3, lines 29-32) and *"In a preferred embodiment of the invention, the UDD files are implemented as XML documents"* (column 4, lines 13-15) where the XML uses: *"Document Type Definition (DTD) is a set of syntax rules for tags. It specifies what tags can be used"* (column 3, lines 27-28).

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to combine the image files with custom tags of Pavley



with the device specific application development of Gao in order to provide *"an input link from the digital camera's UDD, which has an output link to the storage device"* (Gao, column 15, lines 35-36).

19. **Regarding dependent claims 11 and 12**, the claims are directed toward a computer readable medium for the method of claims 2 and 3 respectively, and are rejected using the same rationale.
20. **Regarding dependent claims 17 and 18**, the claims are directed toward a system for the method of claims 2 and 3 respectively, and are rejected using the same rationale.
21. **Regarding independent claim 25**, the claim is directed substantially the same subject matter as claims 1-3 combined, and is rejected using the same rationale.
22. **Regarding dependent claim 26**, Pavley recites: *"In addition to image tags 825, in accordance with the present invention, file attribute designations 1000 are provided for image files"* (column 5, lines 25-27) where Pavley defines file attribute designations as *"file attributes that act as metadata for a file. A minimum subset of file tags referred to herein as file attribute designations for digital image files includes a read-only file attribute, a hidden file attribute, an archive file attribute, and a system file attribute"* (column 5, lines 31-35).
23. **Regarding dependent claims 27 and 28**, Pavley discloses user tags in Figure 5 at reference sign 715, and custom tags at reference signs 720 and 735.

24. **Regarding dependent claim 29**, Pavley recites: *"For example, capture information tags 710 may indicate focus setting, aperture setting, and other relevant information that may be used for effectively processing or analyzing the corresponding image data"* (column 4, line 66 to column 5 line 3).
25. Claims 4-6, 13-15, 19-21 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pavley in view of Gao, and in further view of Manolis et al., US Patent 6,583,799, filed 11/29/1999, patented 6/24/2003 (hereinafter Manolis).
26. **Regarding dependent claims 4 and 5**, Pavley and Gao disclose a method for customizing image file tags in camera applications as described above. Pavley and Gao fail to disclose the use of a database to store image data, or allowing a user network access to the image files. Manolis teaches the use of a database for image file storage and access. Manolis discloses in Figure 7, at reference sign 520, a *"DB Server"* as an element of the *"Image Archive Subsystem"*. Manolis also recites: *"After the user has entered the required information, the user presses the Next button 220 to arrive at the next screen--an image selection window 222 as shown in FIGS. 2B and 2C"* (column 2, lines 32-35).

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to combine the camera application with image files having customized tags of Pavley and Gao with the database storage and user access as taught by Manolis in order to provide *"software that allows a user to perform tasks such as communicating with other computer users, accessing various*

*computer resources, and viewing, creating, or otherwise manipulating electronic content----that is, any combination of text, images" (Manolis, column 1, lines 26-30).*

27. **Regarding dependent claims 13 and 14**, the claims are directed toward a computer readable medium for the method of claims 4 and 5 respectively, and are rejected using the same rationale.
28. **Regarding dependent claims 19 and 20**, the claims are directed toward a system for the method of claims 4 and 5 respectively, and are rejected using the same rationale.
29. **Regarding dependent claims 30 and 31**, the claims contain substantially the same subject matter as claims 4 and 5 respectively, and are rejected using the same rationale.
30. **Regarding dependent claims 6, 15, 21 and 32**, the claims are rejected for fully incorporating the deficiencies of the base claims.

**Conclusion**

31. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

| <u>Patent</u>     | <u>Date</u> | <u>Inventor</u>     |
|-------------------|-------------|---------------------|
| • US-5,633,678    | 05-1997     | Parulski et al.     |
| • US-5,903,309    | 05-1999     | Anderson, Eric C.   |
| • US-5,933,137    | 08-1999     | Anderson, Eric C.   |
| • US-5,943,093    | 08-1999     | Anderson et al.     |
| • US-5,973,734    | 10-1999     | Anderson, Eric C.   |
| • US-5,986,701    | 11-1999     | Anderson et al.     |
| • US-6,094,219    | 07-2000     | Roberts et al.      |
| • US-6,128,038    | 10-2000     | Nakajima, Nobuyoshi |
| • US-6,198,526    | 03-2001     | Ohtsuka, Shuichi    |
| • US-6,233,010    | 05-2001     | Roberts et al.      |
| • US-6,223,190    | 04-2001     | Aihara et al.       |
| • US-6,373,507    | 04-2002     | Camara et al.       |
| • US-6,337,712    | 01-2002     | Shiota et al.       |
| • US-6,426,771    | 07-2002     | Kosugi, Masato      |
| • US-6,437,797    | 08-2002     | Ota, Yoshinori      |
| • US-6,462,778    | 10-2002     | Abram et al.        |
| • US-6,463,177    | 10-2002     | Li et al.           |
| • US-6,493,108    | 12-2002     | Hirai, Shinya       |
| • US-6,496,222    | 12-2002     | Roberts et al.      |
| • US-6,507,857    | 01-2003     | Yalcinalp, L. Umit  |
| • US-6,535,896    | 03-2003     | Britton et al.      |
| • US-2003/0121000 | 06-2003     | COOPER et al.       |

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J Vaughn whose telephone number is (703) 305-4672. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached at (703) 308-5186. The fax phone

Art Unit: 2178

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn  
May 5, 2004

  
STEPHEN S. HONG  
PRIMARY EXAMINER